

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Akio SAITO) : Examiner: Trang U. Tran
Appln. No.: 09/822,189) : Group Art Unit: 2622
Filed: April 2, 2001) : Confirmation No: 7310
For: INFORMATION PROCESSING) :
APPARATUS AND METHOD, AND) :
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APPARATUS AND METHOD : April 16, 2007

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APPELLANT'S BRIEF ON APPEAL

Introduction

LaJoie et al. teaches the superimposition of program information on television programs for 2 seconds, upon changing channels. This fixed display duration disadvantages slow readers who cannot read the entire text in 2 seconds and fast readers who have their programs obscured by text longer than necessary. Independent Claim 25 solves this problem by displaying a screen for setting the duration of program information display, upon changing to a new channel. The Final Rejection proposes adding such a setting screen to LaJoie et al. because Figure 21 of Kayashima et al. shows a screen for setting a completely different television function — the sleep timer of the television — in 30-minute increments. Neither patent recognizes the disadvantages of a fixed program-information display time. And neither patent suggests the desirability of changing LaJoie et al.'s fixed program-information display time to a customizable display time using Claim 25's setting screen. The most obvious and simplest way to combine these reference teachings is to merely add a sleep-timer screen and function to LaJoie et al., producing both a fixed-time program display and a settable sleep function. In contrast, the Examiner never explain why the skilled artisan would be motivated to combine these reference teachings in a much more complicated way to alter LaJoie et al.'s fixed program-information display time without any recognition in the art of the desirability of this change. Therefore, Appellant submits that only the impermissible use of hindsight would suggest modifying LaJoie et al.'s fixed, 2-second, program-information display time in view of Kayashima et al.'s screen for setting a sleep timer in 30-minute increments. For these reasons, the rejection of Claim 25 and its dependent claims for obviousness over these patents should be reversed.

I. Real Party in Interest

The real party in interest is Canon Kabushiki Kaisha, Assignee of the full and exclusive right for the territory of the United States of America in and to the invention described and claimed in the present application. The Assignment, executed May 25, 2001, was recorded on June 20, 2001, at Reel 011920, Frame 0325.

II. Related Appeals and Interferences

Appellant, Appellant's legal representative, and the Assignee are not aware of any other appeals or interferences that will directly affect, be directly affected by, or have a bearing on, the Board's decision in the instant appeal.

III. Status of the Claims

Claims 25-33 and 35 have been finally rejected. Claims 1-24, and 34 have been canceled. Appellant is appealing the rejection of Claims 25-33 and 35. The full text of each appealed claim appears in Appendix A. The relationship between the claims is shown in Appendix B.

IV. Status of Amendments

In response to the June 5, 2006 Final Rejection, Appellant filed a Request for Reconsideration on October 13, 2006. Page 1 of the November 13, 2006 Advisory Action indicates that the October 13, 2006 Request has been considered, but does place the application

in condition for allowance. The claims were not amended after the issuance of the June 5, 2006 Final Rejection.

V. Summary of the Claimed Subject Matter

According to one aspect, the present invention relates to a method of permitting a viewer to confirm the contents of a television program when a channel is changed. This is accomplished by superimposing program information about the new television program for a predetermined period of time on the video image of a television program, as shown in Figure 5. (Page 3, lines 2 through 24. Page 10, lines 13 through 16.)

The program information is provided as text to be read, while the television program is provided as video images to be viewed. Because one is superimposed on the other, the text of the program information obscures the video images of the displayed television program for the amount of time the text is displayed. As a result, the program information is usually displayed for a short amount of time, for example, 2 seconds (as taught by the LaJoie et al. patent) to minimize the inconvenience to the viewers. But different viewers have different reading speeds and different tolerances for the amount of time a television program is obscured by program-information text. If the program information is displayed for a shorter period of time than it takes for the viewer to read the text, the viewer will be unable to read the entire program information and can become frustrated. On the other hand, if the program information is displayed for more time than the viewer takes to read the text, the television program will be obscured for longer than necessary, also leading to frustration among some viewers.

Conventional approaches as taught in the La Joie et al. patent, do not address this issue of the variability of user reading speeds and preferences. The present invention, as discussed in detail below, solves this problem by providing a method to customize the program-information display duration.

As shown in Figure 1, the present invention employs a tuner 101, which receives program information data (in the form of an Electronic Program Guide (EPG)), transmitted together with video data. The EPG can comprise, for example, the channel number, the program name, the contents of the program, and the cast of the program, as shown in Figures 4 through 7. (Page 14, lines 2 through 17.) All of this data is descrambled by a descrambler 102 and demultiplexed by a demultiplexer 103, and the EPG data is then separated from the video data, decoded by an EPG decoder 106, and transmitted to a control unit 115, which stores the EPG data in a memory 116. (Page 5, line 7 through page 6, line 22.) When the channel is changed, the control unit 115 reads the EPG data of the program currently being received on the new channel from the memory 116 and outputs the read EPG data to a program information display signal creation unit 108, which transmits the EPG data for the current program to the image display unit 113 of the television via a display control unit 110 to superimpose the program data of the currently viewed program on the video images of that program. (Page 10, line 6, through page 12, line 13. Figures 1-3.)

The amount of time the EPG data is displayed is manually controlled by a user via the program information setting screen shown in Figure 9. The program information setting screen includes an area 904 for setting the amount of time during which the EPG data is displayed. Five

choices are displayed for the program-information display time: "VERY LATE"; "LATE"; "COMMON"; "EARLY"; and "VERY EARLY". (Page 17, lines 20-27.) To display this program-information, display-setting screen, the user depresses a menu button 804 on a remote controller shown in Figure 8. The user then moves a selection cursor 900 to the desired program-information display time on the displayed screen by operating the cursor buttons 805 on the remote controller and depresses a selection button 806 on the remote controller to select the display time over which the cursor is placed. The user next moves the cursor to a decision button 910 on the screen and again depresses the selection button to select the selected display time. (Page 15, line 16 through page 17, line 6.)

In this manner, the user can customize the duration of automatic program-information display to suit his or her preferences and reading speed. Thus, the present invention comprises a customizable program-information, display-time method.

In accordance with MPEP § 1205, each element recited in the claims is identified below with a corresponding element described in the specification. However, it should be understood that the claimed elements are not limited to the specific structure to which they correspond as described in the specification.

A. Independent Claim 25

Independent Claim 25 relates to an information processing method comprising the step of inputting video data and program information data into an apparatus. (Page 5, line 7 though page 6, line 16. Page 10, lines 17 through 26. Step S302 in Figure 3.) Claim 25 also recites that the

method comprises the step of displaying video images of a first program derived from the inputted video data on a display device. (Page 11, lines 3 and 4. Step S304 in Figure 3. Figures 4 through 7 at time t0.) The method further comprises the step of displaying on the display device, in response to a change from the first program to a second program, program information for the second program derived from the inputted program information data, together with video images of the second program derived from the inputted video data. (Page 5, lines 7 through 10. Page 6, line 23 through page 7, line 1. Page 9, lines 9 through 24. Page 12, lines 4 through 13. Page 13, line 18 through page 14, line 17. Page 18, lines 20 through 25. Steps S307, S308, S310, S304 in Figure 3. Figures 4 through 7 at times t1, t2, and t3.) The method also comprises the step of displaying a setting screen for setting the duration of program information display for the second program. (Page 16, lines 4 through 10. Page 17, lines 20 through 27.) In addition, Claim 25 recites that the duration of the program-information display for the second program meets a condition set at the setting screen. (Page 14, lines 14 through 17. Page 16, line 24 through page 17, line 1. Page 17, lines 20 through 27.)

B. Dependent Claims 26-33 and 35

Dependent Claim 26 recites a reception step, of receiving transport stream data transmitted by digital television broadcasting. (Page 5, lines 4 through 9). Claim 26 also recites a deriving step, of deriving the video data from the transport stream data received in the reception step (Page 5, line 14 through page 6, line 16).

Dependent Claim 27 also recites a reception step, of receiving transport stream data transmitted by digital television broadcasting. (Page 5, lines 4 through 9.) Claim 27 also recites a deriving step, of deriving the program information data from the transport stream data received in the reception step. (Page 5, lines 7 through 13. Page 6, lines 7 through 22.)

Dependent Claim 28 recites the step of storing in a memory the program information data derived in the deriving step, wherein the program information for the second program is derived from the program information data stored in the memory. (Page 6, line 17 through page 7, line 1. Page 8, line 9 through page 10, line 5. Page 10, line 27 through page 13, line 14.)

Dependent Claim 29 recites a manual setting step, of setting contents of the program information to be displayed in the program information displaying step. (Page 16, line 4 through page 18, line 19.)

Dependent Claim 30 recites that the manual setting step includes setting at least one of a display timing, a display area, a display character size, a display method, a number of display repetitions, and display contents. (Page 16, line 4 through page 18, line 19.)

Dependent Claim 31 recites that the program information display step includes displaying, in response to turning on of the apparatus, the program information for the first program derived from the program information data, together with video images of the first program derived from the input video data. (Page 10, line 17 through page 11, line 21.)

Dependent Claim 32 recites that the program information display step includes displaying program information for the second program on the display device in response to a broadcast end

of the first program, followed by a broadcast of the second program and display of the video images of the second program. (Page 14, line 18 through page 15, line 2.)

Dependent Claim 33 recites that the program information displaying step includes displaying video images of the second program derived from the input video data include commercial video images and, in response to a change from the first program to the second program, the program information for the second program is displayed on the display device together with the commercial video images. (Page 19, lines 4 through 11. Page 20, lines 19 through 26.)

Dependent Claim 35 recites that the second program is displayed so as to veil a part of the video image of the second program. (Page 11, lines 10 through 21.)

VI. Grounds of Rejection to be Reviewed on Appeal

The rejection to be reviewed on appeal is the rejection of Claims 25-33 and 35 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,850,218 (LaJoie et al.) in view of U.S. Patent No. 5,488,427 (Kayashima et al.).

Independent Claim 25 recites the step of displaying a setting screen for setting the duration of program information display for a video program, permitting viewers to match the display time for explanatory text superimposed on a television program to their reading speed. The issue on appeal is: Since independent Claim 25 recites displaying a screen for setting the program-information display time, while (i) the patent to LaJoie et al. discloses a *fixed*, 2-second program display time, (ii) the Kayashima et al. patent does not display any program information

at all, but merely displays a settable television timer, and (iii) neither patent recognizes the need to match the display time to the viewer's reading speed, should the rejection of Claim 25 for obviousness over these patents be reversed?

VII. Argument

Since Claim 25 is the only independent claim pending in the case, the arguments below are directed to Claim 25. Appellant submits that these arguments are also applicable to the dependent claims.

A. The Patent Office has not satisfied the three criteria for establishing a *prima facie case of obviousness against Claim 25 set forth in MPEP § 2142 and § 2143*.

1. The Office has not satisfied the all-limitations criteria

MPEP § 2142 requires the cited art to disclose or suggest *all* the claimed features. But here, neither the patent to LaJoie et al., nor the patent to Kayashima et al. discloses or suggests the step of displaying a setting screen for setting the duration of program information display, as recited by Claim 25.

Rather, the LaJoie et al. patent relates to a conventional interactive program guide in which, after a channel is changed, “a program information banner . . . is preferably displayed for a fixed period of time (e.g. 2 seconds) or until an information key . . . is depressed . . .” (column 15, lines 19 - 27) (emphasis added). This patent is not understood to disclose any way to customize the duration of automatic program information display. As a result, the program guide described in this patent cannot be set to accommodate different viewers' different reading speeds

and preferences. Moreover, page 3 of the June 5, 2006 Office Action admits that this patent does not disclose this feature (“. . . Lajoie et al explicitly do not disclose the newly added claimed [feature] that the displaying [of] a setting screen sets the duration of program information display . . .”).

The cited Kayashima et al. patent is not even understood to teach the display of program information. Rather, this patent is understood to merely relate to a conventional television system incorporating a VCR deck, a CD player, a tape deck, and a radio tuner, and a remote control that is designed to control all of these devices (column 1, lines 5 through 41).

Embodiment 6, which the June 5, 2006 Office Action cites, relates to the use of on-screen programming to control all of these devices, using different display screens and the remote control. To control the television portion of the system, the screen shown in Figure 21 is displayed. One of the fields on this screen is labeled “TIMER” and adjacent thereto are five boxes, labeled “0”; “30 MIN”; “60 MIN”; “90 MIN”; AND “120 MIN”. The only description of this figure states “FIG. 21 shows a television setting menu screen”. (column 7, line 12).

Appellant submits that, given the depicted times of “30 MIN”, “60 MIN”, etc., one skilled in the art would recognize this menu as relating to the amount of time the television set operates before turning off. Such a function is well-known as the television set’s “sleep” function, where a timer controls how long the television operates before automatically turning off. Certainly, one skilled in the art would not understand this “TIMER” menu to set a program-information display time of 30 minutes, 60 minutes, etc., because 1) the Kayashima et al. patent is not understood to display program information, and 2) it is completely inappropriate to set such long program-information

display times. Thus, this patent also does not disclose or suggest the step of displaying a setting screen for setting the duration of program-information display, as recited by Claim 25.

Further, Appellant submits that the logical combination of these two patents would not result in the claimed setting screen. Instead, Appellant submits that the most obvious and logical combination of these two patents would merely result in a television that has a fixed, 2-second display time for displaying program information, and a menu screen for setting a timer to operate the television for 30 minutes, 60 minutes, etc., before turning itself off.

Since neither the patents themselves, nor their logical combination discloses or suggests at least one feature of Claim 25, the all-limitations criteria of MPEP § 2142 has not been satisfied, and for this reason, the Office has not satisfied its burden of proof to establish a prima facie case of obviousness against Claim 25.

2. The Office has not satisfied the motivation-to-combine criteria

MPEP § 2142 also requires a legally sufficient motivation to combine the references to produce the claimed invention to support a prima facie case of obviousness:

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references". Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP § 2144 - § 2144.09 for examples of reasoning supporting obviousness rejections

But here, the references do not expressly or impliedly suggest the claimed invention, and the reasoning outlined in the June 5, 2006 Office Action and the November 13, 2006 Advisory Action is unconvincing because it is unsupported by knowledge generally available to those skilled in the art, scientific principles, or legal precedent, as required by MPEP § 2144, as will be discussed below.

- a. The references fail to expressly or impliedly suggest the program-information-duration, setting-screen display step

The patents to LaJoie et al. and Kayashima et al. do not expressly or impliedly suggest displaying a setting screen for setting the duration of program information display, as recited by Claim 25. Nor has the Examiner pointed to anything in these references or the general knowledge of one skilled in the art to motivate or suggest to one skilled in the art to modify the fixed duration program information display of LaJoie et al. to use a setting screen for setting the duration of program display. In particular, there is nothing in either patent that recognizes the above-mentioned drawback of the fixed duration display (i.e., disadvantaging slow or fast readers), that recognizes any other drawback of the fixed duration display, or that recognizes any advantage of user-controlled setting of the duration of information display. Without any such recognition, Appellant submits that there is no reason one skilled in the art would have been led to modify the fixed duration information display of LaJoie et al. at all, much less in the manner suggested in the Office Action, to display a setting screen for setting the duration of the program information display.

Further, Appellant submits that nothing expressed or implied in Kayashima et al. would have led one skilled in the art to modify the device of LaJoie et al. in the particular manner suggested by the Examiner.

The June 5, 2006 Office Action cites the Kayashima et al. patent to show “a television setting menu screen having [a] timer having five durations 0 minute, 30 minutes, 60 minutes, 90 minutes, and 120 minutes to be set by the user. . . .”, and the November 13, 2006 Advisory Action argues that 1) a reference must be considered for what it fairly suggests, and 2) the artisan is presumed to know something about the art apart from what it literally discloses. But, the Advisory Action fails to provide any detailed reasoning that would explain how a patent that does not teach the display of any program information would imply the customizing of the display time for such program information, as recited by Claim 25. In particular, there is no indication of how a teaching of a menu to set a timer for turning off a television in increments of 30 minutes would lead one skilled in the art to provide a screen for setting the duration of program-information display for a duration measured in seconds. Appellant submits that the mere teaching of a screen for setting a duration of one parameter does not provide the motivation for one skilled in the art to provide a setting screen for setting every other parameter in a device, and it certainly does not provide the motivation to provide a setting screen for the particular parameter of the program-information display duration (especially when, as discussed above, there has been no recognition in the art of any drawback to the fixed-duration program information display). Accordingly, the Advisory Action has not established that the references impliedly suggest this feature of Claim 25.

- b. The Office fails to provide a convincing line of reasoning to combine the references based on generally available knowledge, established scientific principles, or legal precedent.

The June 5, 2006 Office Action fails to provide a convincing line of reasoning as to why the references would have been combined to obtain the claimed invention, as can be seen from this except from page 3 of the Office Action:

Therefore, it would have been obvious to one [of] ordinary skill in the art at the time of the invention to incorporate the timer setting as taught by Kayashima et al into LaJoie et al's system in order to allow the user to easily manipulate the device even [if] the user [is] unfamiliar with the operation of the device.

This passage posits that the skilled artisan would be motivated to combine the teachings of the patents to Kayashima et al. and LaJoie et al. to produce the claimed invention because to do so would make it easier for the unfamiliar user to manipulate the device. Such a rationale is discussed at column 6, lines 33-35 of the Kayashima et al. patent. In that patent, the inventors propose to replace a complex remote control, which operates a television system comprising a VCR, a disc layer, a tape deck, a radio tuner, and a television set, with on-screen programming. The patent explicitly states that on-screen programming is easier for the novice to use than a complicated remote control. But this reasoning cannot be applied to the addition of a program-information-duration setting screen to the LaJoie et al. patent for four reasons.

First, adding a program-information-duration setting screen to the LaJoie et al. patent complicates LaJoie et al.'s program guide because the LaJoie et al. patent *does not permit the user to set the duration of program information display*. Adding such control adds to the

complexity of the program guide, adds to the complexity of the user interface, and adds to the complexity of the user experience. Thus, the Office Action's rationale is factually incorrect.

Second, to use Kayashima et al.'s on-screen-programming rationale in this case to increase the ease of use presupposes that it is already known for the user to select the program information duration by some method more complicated than on-screen programming. Otherwise, it would not be easier for the user to manipulate the program information display duration by using on-screen programming. *But this assumption is false.* There is no evidence of record that the art discloses the user setting of the program-information display duration.

Third, the June 5, 2006 Office Action fails to establish that knowledge generally available to the skilled artisan or established scientific principles teach the use of a program-information-duration setting screen for user selection of the program information duration.

Fourth, the June 5, 2006 Office Action cites no legal precedent from which to argue the obviousness of adding a program-information-duration setting screen to the LaJoie et al. patent.

Thus, under MPEP § 2144, the June 5, 2006 Office Action fails to establish a legally sufficient motivation to combine the art to produce the invention of Claim 25.

Perhaps for that reason, the November 13, 2006 Advisory Action provides a completely different rationale for combining the art to produce the claimed invention. In fact, pages 2 and 3 of the Advisory Action provide three separate obviousness arguments:

It is recognized by appellant, Kayashima et al [was] cited only to suggest the television setting menu screen for setting the timer. The timer setting of Kayashima et al has similar application whether the setting is the timing of the information banner or the program-information-banner-display duration. A reference must be considered not only for what it expressly teaches, but also for

what it fairly suggests. In re Burckel, 592 F.2d 1175,201 USPQ 67 (CCPA 1979). The artisan is presumed to know something about the art apart from what references literally disclose. In re Jacoby, 309 F.2d 513,135 USPQ 317 (CCPA 1962). The examiner believes that the artisan would have recognized the obviousness of setting the timer as taught by Kayashima.

But these obviousness arguments likewise suffer fatal defects, as will now be discussed.

First, the Advisory Action argues that because the timer setting screen of the Kayashima et al. patent has an application similar to the setting of the program-display duration, it would be obvious to use it to set the program-display duration in the LaJoie et al. patent. But it is untrue that the Kayashima et al. patent applies its timer screen to a function similar to the program-information display time. This patent is completely silent as to the use of its timer screen. As a result, there is no evidence that its application is similar to Appellant's. Further, why would the skilled artisan change the fixed-time program display of the LaJoie et al. patent to a customizable program-display time, merely because it is known to set different times of a timer for unspecified television functions? The Advisory Action never answers this crucial question. Moreover, to the extent one skilled in the art could surmise the function of the TIMER screen in Kayashima et al., the possible selections in increments of 30 minutes suggest that this screen sets the time at which the television will be automatically turned off (e.g., the well-known sleep function), rather than the duration of the display of information. In addition, the Advisory Action never discusses why the skilled artisan would be motivated to create a screen to set the time of program-information display based on knowing the existence of a screen for setting the sleep time of the television. In the absence of any discussion of the desirability of setting the program-information display time

in the references, the Advisory Action's argument merely becomes: because the references can be combined, it would be obvious to do so. But, MPEP § 2143.01 III prohibits this type of reasoning to establish a *prima facie* case of obviousness, *since the references never suggest the desirability of a customizable program-information display time*: "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination". (Emphasis in the original.)

Second, this passage argues that the timer screen in the Kayashima et al. patent fairly suggests its use to change the fixed program-information display time in the LaJoie et al. patent to a customizable program display time. But, what disclosure in the Kayashima et al. patent suggests changing the fixed program-information display time in the LaJoie et al. patent to a customizable program display time, to accommodate different viewers' reading speeds? In other words, which portion of either of these patents suggests the desirability of changing the program-information display time? The Advisory Action never answers these questions.

Third, this passage argues that because the artisan is presumed to know something about the art apart from what references literally disclose, that the artisan would be motivated to change the fixed program-information display time in the LaJoie et al. patent to a customizable program display time. But, again why? What is this knowledge possessed by skilled artisans that would motivate them to change the fixed program-information display time in the LaJoie et al. patent to a customizable program display time to accommodate different viewers' reading speeds? The Advisory Action never says.

Thus, the Advisory Action completely fails to provide the required motivation for combining the references to produce the displaying step recited in Claim 25. Since neither the June 5, 2006 Office Action, nor the November 13, 2006 Advisory Action establish a legally sufficient motivation to combine the references to produce the claimed invention under MPEP § 2143, the Office has not satisfied its burden of proof to establish a *prima facie* case of obviousness against Claim 25.

3. The Office has not satisfied the reasonable-expectation-of-success criterion

MPEP § 2142 further requires that there be a reasonable expectation of success when modifying the art to produce the claimed invention and that “the reasonable expectation of success must . . . be found in the prior art, and not based on appellant’s disclosure”. But here, the patents to Kayashima et al. and LaJoie et al. do not disclose or suggest a program-information-duration setting screen for user selection of the program information duration, as recited by Claim 25. In addition, the June 5, 2006 Office Action does not discuss this issue, while the Advisory Action merely repeats the same conclusory argument quoted above to establish a reasonable expectation of success. Thus, neither the June 5, 2006 Office Action, nor the Advisory Action provide any evidence that the skilled artisan would be reasonably expected to succeed in modifying the fixed-display time method disclosed in the LaJoie et al. patent to produce a customizable program-information display time. As a result, the Examiner has not established any reasonable expectation of success that is “found in the prior art, and not based on

appellant's disclosure". Therefore, the Office has not satisfied its burden of proof under MPEP § 2142 to establish a reasonable expectation of success.

- B. The Patent Office bears the burden of proof to establish a prima facie case of obviousness against Claim 25 and has not satisfied that burden because the Final Rejection and Advisory Action fail to base their conclusion of obviousness on facts gleaned from the prior art
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MPEP § 2142 places the initial burden on the Office to factually support any prima facie conclusion of obviousness. Therefore, to reject Claim 25, the Office must allege facts showing that the step of displaying a setting screen for setting the duration of program information display, would have been obvious to one skilled in the art. And that factual burden must be satisfied without resort to Appellants's own disclosure:

To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of appellant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon appellant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art. (MPEP § 2142)(emphasis added)

Thus, to reject Claim 25 for obviousness, the Office must rely on facts gleaned from the prior art to render obvious the customization of the program-information display time. But the

only document that discloses or suggests the desirability of a providing a customizable program-information display time is Appellant's own disclosure. The prior art is silent on this crucial feature. Instead, the LaJoie et al. patent teaches a fixed, 2-second program-display time, while the Kayashima et al. patent does not even disclose the display of program information, let alone a way for the user to set the program-information display duration. Moreover, neither patent recognizes the disadvantages of a fixed program-display time or discloses or suggests the desirability of customizing the program-display time.

Since the only document of record that recognizes the disadvantages of a fixed program-display time and suggests the desirability of customizing the program-display time is Appellant's own disclosure, Appellant submits that the Office's conclusion of obviousness is based on impermissible hindsight in using Appellant's own disclosure to provide the suggestion to modify the references to produce the invention of Claim 25. Therefore, the Office has not satisfied its burden of proof to establish a *prima facie* case of obviousness against Claim 25 for this additional reason.

VIII. Claims Appendix

A. Text ofAppealed Claims

Claim 25 (Previously Presented) An information processing method comprising the steps of:

inputting video data and program information data into an apparatus;
displaying video images of a first program derived from the inputted video data on a display device;
displaying on the display device, in response to a change from the first program to a second program, program information for the second program derived from the inputted program information data, together with video images of the second program derived from the inputted video data; and
displaying a setting screen for setting the duration of program information display for the second program,
wherein the duration of the program information display for the second program meets a condition set at the setting screen.

Claim 26 (Previously Presented) An information processing method according to claim 25, wherein said inputting step includes:

a reception step, of receiving transport stream data transmitted by digital television broadcasting; and

a deriving step, of deriving the video data from the transport stream data received in said reception step.

Claim 27 (Previously Presented) An information processing method according to claim 25, wherein said inputting step includes:

a reception step, of receiving transport stream data transmitted by digital television broadcasting; and

a deriving step, of deriving the program information data from the transport stream data received in said reception step.

Claim 28 (Previously Presented) An information processing method according to claim 27, further comprising the step of storing in a memory the program information data derived in said deriving step, wherein the program information for the second program is derived from the program information data stored in the memory.

Claim 29 (Previously Presented) An information processing method according to claim 25, further comprising a manual setting step, of setting contents of the program information to be displayed in said program information displaying step.

Claim 30 (Previously Presented) An information processing method according to claim 29, wherein said manual setting step includes setting at least one of a display timing, a display

area, a display character size, a display method, a number of display repetitions, and display contents.

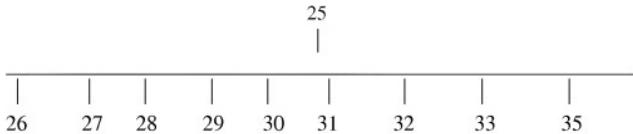
Claim 31 (Previously Presented) An information processing method according to claim 25, wherein said program information display step includes displaying, in response to turning on of the apparatus, the program information for the first program derived from the program information data, together with video images of the first program derived from the input video data.

Claim 32 (Previously Presented) An information processing method according to claim 25, wherein said program information display step includes displaying program information for the second program on the display device in response to a broadcast end of the first program, followed by a broadcast of the second program and display of the video images of the second program.

Claim 33 (Previously Presented) An information processing method according to claim 25, wherein said program information displaying step includes displaying video images of the second program derived from the input video data include commercial video images and, in response to a change from the first program to the second program, the program information for the second program is displayed on the display device together with the commercial video images.

Claim 35 (Previously Presented) The method according to claim 25, wherein the program information for the second program is displayed so as to veil a part of the video image of the second program.

B. Relationship of Claims To Each Other



IX. Evidence Appendix

None

X. Related Proceedings Appendix

None

XI. Conclusion

Since the only document of record that recognizes the need to match the viewer's reading speed to the program-information display time is Appellant's own disclosure, and since Appellant's own disclosure is the only document of record that satisfies this need by displaying a setting screen for setting the duration of program information display, the Examiner has not established a prima facie case of obviousness against independent Claim 25. Therefore, the rejection of independent Claim 25 and dependent Claims 26-33 and 35 must be reversed.

Appellant's undersigned attorney may be reached in our Washington D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

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